

REMARKS

Claims 1 and 3-15 will be pending upon entry of the present amendment. Claims 14 and 15 are new. No new matter is being presented.

Objection to Specification

The Examiner has objected to the arrangement of the specification. Applicants have filed herewith a substitute specification that includes headings. It is respectfully submitted that the objection should be withdrawn.

Office Action's "Response to Arguments" Section and Claim Rejections Fail to Address Applicants' Arguments

The Office Action fails to address the arguments presented in Applicants' previous response and therefore fails to provide Applicants with the opportunity to meaningfully respond to the Office Action. Applicants supported their positions for patentability on numerous different grounds, provided detailed analysis supporting patentability, pointed to relevant disclosure in the cited references, and cited relevant case law. Even though Applicants pointed out legal deficiencies in the rejections and set forth grounds for patentability, the Office Action merely stated that the Applicants' remarks are moot in view of the new grounds of rejection and then proceeds to reject the claims on the art cited in the previous Office Action (Office Action dated March 18, 2008). Office Action, page 2, section 2. Accordingly, Applicants respectfully request that (1) the Examiner reconsider the application based on the arguments set forth herein; (2) if the Examiner rejects the claims, to provide a detailed substantive response (*e.g.*, a response that sets forth why the Applicants' arguments are not persuasive); and (3) if the Examiner maintains the current rejections, that the next Office Action be made non-final, and include a detailed substantive response to the arguments presented by the Applicants.

Examiner Should Consider Applicants' Arguments

The M.P.E.P. and the case law makes clear that office personnel should consider all rebuttal arguments and evidence presented by Applicants. M.P.E.P. § 2145. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of

ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness. Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection requires that the Applicants be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability. M.P.E.P. § 2141.

Here, Applicants have provided detailed reasons why the claims are patentable based on (1) differences between the cited references and the claims supporting non-obviousness, (2) one of ordinary skill in the art being deterred from modifying the cited references, (3) Office Action's proposed combination is unsuitable for Donnelly's intended purpose of protecting and disassembling a tool from the personal communication device before using the Donnelly tool, (4) Office Action's proposed combination involves substantial reconstruction and changes the basic principle of operation of the Nakamura lid and Donnelly belt clip tool, and (5) Office Action bases its rejections on conclusory statements without any rationale to support the legal conclusion of obviousness. Applicants are unable to find in the outstanding Office Action any explanation to support the obviousness rejection with respect to these five independent reasons supporting patentability.

Applicants' Legal Arguments Must Be Considered

The M.P.E.P. and case law clearly require that inquiries addressed in Applicants' legal arguments must be considered. The M.P.E.P. and case law make it clear that obviousness is based on "[a]scertaining the differences between the claimed invention and the prior art" (M.P.E.P. § 2141 (II)); the "prior art must be considered in its entirety, including disclosures that teach away from the claims" (M.P.E.P. § 2141.02 (VI)), the proposed modification cannot render the prior art unsatisfactory for its intended purpose (M.P.E.P. § 2143.01 (V)); and the proposed modification cannot change the principle operation of the references (M.P.E.P. § 2143.01(VI)) (emphasis added). Here, the Office Action fails to address any of these. Applicants are left wondering what rationale supports the Examiner disregarding the Applicants' contentions, why

the Office Action fails to find Applicants' arguments to be persuasive, why the Office Action fails to address the Applicants' contentions, and why the Office Action merely restates old rejections without any discussion with the appropriate inquires set forth in the M.P.E.P.

Applicants' legal arguments and contentions are set forth in detail below, and Applicants respectfully request reconsideration of the pending application.

Rejections of Claims 1 and 3-7 Under 35 U.S.C. § 103(a)

Claims 1 and 5-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,529,714 to Nakamura *et al.* ("Nakamura") in view of U.S. Patent No. 5,531,365 to Donnelly ("Donnelly"). Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of Donnelly, further in view of U.S. Patent No. 3,870,184 to Fuchs *et al.* ("Fuchs"). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of Donnelly, further in view of U.S. Patent No. 5,260,146 to Savovic *et al.* ("Savovic"). Applicants respectfully submit that claims 1 and 3-13 are patentable for at least the reasons set forth below.

Differences Between the Cited References and the Claims Support Non-Obviousness

It is respectfully submitted that the differences between the cited references and the claims establish that the claims are non-obvious. Obviousness is a question of law based on underlying factual inquiries including ascertaining the differences between the claimed invention and the prior art. M.P.E.P. § 2141 (II); *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). The claims recite particular arrangements (*e.g.*, structural interrelationship limitations) among the features that are not taught or suggested by the cited references. Independent claim 1 recites, among other things, that the portable electronic apparatus includes a battery compartment lid that covers at least partly a battery pack and a battery compartment, and the battery compartment lid is a lever element arranged to bend a material of lower hardness by way of a leverage effect. Independent claim 6 recites, among other things, that a battery compartment lid covers at least partly a battery pack and a battery compartment, and the lid is a leverage element structured to remove a bottle cap from a bottle by bending the bottle cap using the leverage effect. Independent claim 7 recites, among other things, that the housing includes a battery compartment lid being a lever element that is integrally arranged in the wall of the

synthetic material structure and arranged to bend material by way of leverage effect and is arranged to cover at least partly a battery pack. Neither Nakamura nor Donnelly makes any mention of, or even recognizes, such claimed relationships between a battery compartment lid and housing, namely that the battery compartment lid is both integrally arranged or embedded in a wall and a lever element that bends a bottle cap by way of a leverage effect. Indeed, the Examiner recognizes that Nakamura fails to disclose the claimed limitations and points to Donnelly. (*See, e.g.*, Office Action, page 5, first paragraph.) Donnelly merely discloses a belt clip 60 that is specifically designed to couple to an adapter 6, not a lid, of a personal communications device. (*See, e.g.*, claims 1 and 10; col. 5, lines 33-43.) The Examiner points to the Donnelly belt clip 60 as a leverage element. However, the cited Donnelly belt clip 60 is not a battery compartment lid, much less a battery compartment lid that is integrally arranged or embedded in a wall of a housing and that also bends a bottle cap. Donnelly discloses that a multi-purpose tool 62 of the belt clip 60 is designed to be disassembled from the personal communications device 2 before use. (Col. 6, lines 11-14.) (emphasis added).

The Office Action states that Donnelly teaches a battery compartment lid and cites Figures 1-10; col. 5, lines 12-18, 44-67; col. 6, lines 1-22, 58-67, that fails to identify any feature in the figures or specific text corresponding to a battery compartment lid. (Office Action, page 5, first full paragraph.) Applicants have studied the cited figures and passages in the Office Action and are unable to locate any disclosure of a battery compartment lid, much less the battery compartment lid as claimed. Applicants note that the Office Action then states that “it would be obvious to integrate the belt clip [*i.e.*, a lever element] into the battery compartment lid and so that users are not required to have a separate element to open/remove a bottle cap.” (Office Action, page 5, first paragraph.) The Office Action relies on *In re Larson*, 144 U.S.P.Q. 347 (C.C.P.A. 1965). The Examiner then proceeds to take the position that it is obvious to integrate the belt clip 60 of Donnelly into the battery compartment lid of Nakamura. Applicants note that the claims are not merely directed to a battery compartment lid that is integrally arranged in a wall of the housing. Instead, as detailed above, the claims recite particular arrangements among the features that are not taught or suggested by the cited references. The Examiner misapplies *In re Larson* to take the position that one of ordinary skill in the art would

arrange a battery compartment lid integrally with a walled housing, integrate a lever element into a portion of the Nakamura device (in particular, integrate the lever element into the battery compartment lid), and position the lever element such that it can be used to open/remove a bottle cap. (Office Action, page 4, first full paragraph.) The Office Action is simply picking and choosing various features from the cited references, recombining the features and cited references without a proper motivation to do so, and merely cites a case law directed to the fact that making multiple components integral is obvious.

The belt clip 60 of Donnelley is designed to be disassembled from a personal communication device 2 before use. The Office Action has failed to point to any battery compartment lid in Donnelley, fails to provide a motivation to integrate the belt clip 60 into any battery compartment lid, and provides a proper motivation to do so. Nakamura and Donnelly, alone or in combination, thus fail to disclose, teach, or suggest the structural relationship of a battery compartment lid being both integrally arranged or embedded in a wall of a housing and being a lever element that bends a bottle cap by way of a leverage effect. Applicants were the first to recognize the desirability of such a claimed arrangement.

One of Ordinary Skill in the Art Would Be Deterred From Modifying Nakamura With Donnelly as Proposed in the Office Action

It is respectfully submitted that the teachings of Nakamura and Donnelly would deter one of ordinary skill in the art from making the modifications proposed in the Office Action. A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Nakamura's thin-walled construction, smooth exterior surfaces, and desired lid functionality would discourage one of ordinary skill in the art from the Office Action's proposed modification of Nakamura and Donnelly.

Radio communication equipment is known to be made as lightweight as possible. Lightweight plastics are often used to make housings and other components of such equipment. The Nakamura telephone has the thin-walled housing 2 and the thin-walled lid 3 consistent with minimizing the overall weight of the telephone. These components are not designed for applying leverage, let alone leverage large enough to bend bottle caps. Using the Nakamura lid 3 to

somehow bend bottle caps could cause, for example, fracturing, bending, and/or breaking of the lid 3.

The Nakamura lid 3 is also designed to cooperate with the housing 2 to provide a smooth external gripping surface. Figure 2 of Nakamura shows the smooth external surfaces of the telephone 1 that provide a comfortable grip. Using the Nakamura lid 3 to bend a bottle cap could permanently deform the lid 3 resulting in unwanted outwardly protruding edges of the lid 3 that would destroy the smooth contour of the telephone 1.

Conventional battery lids and housings of telephones have locking features that cooperate to provide a secure fit between the lids and housings. However, these locking features are not configured to withstand the stresses experienced when bending bottle caps. By way of example, the Nakamura housing 2 has relatively small rails (labeled in Figure 1 of Nakamura reproduced below) for slidably engaging the lid 2. The rails could break if the Nakamura lid 3 is used as a bottle opener. The rails are for guiding the lid 3 upwardly and downwardly along the housing 2, not for withstanding stresses produced when bending bottle caps, much less withstanding those stresses without being damaged so as to allow opening and closing of a recess 2A. Broken rails could prevent proper operation of the lid 3. One of ordinary skill in the art would recognize the importance of being capable of repeatedly opening and closing the battery lid to replace or reposition a battery or battery pack.

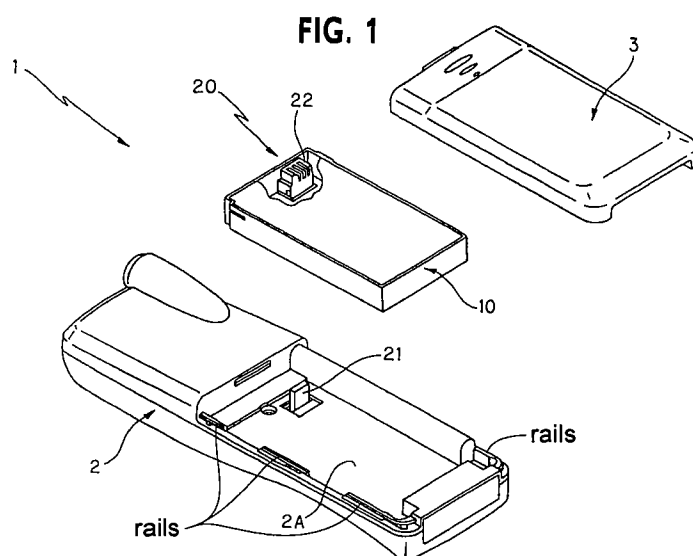


Figure 1 of Nakamura

Assuming *arguendo* that the Nakamura lid 3 could be modified to have the functionality of the Donnelly belt tool 60, the forces applied to the lid 3 to bend a bottle cap could result in significant stresses that could cause damage (*e.g.*, permanent deformation, fatigue damage, etc.) of mated portions of the lid 3 and housing 2, resulting in inoperability of the lid 3.

The lid 3 of Nakamura mates with the housing 2 to prevent external contaminants from entering the battery storing recess 2a shown in Figure 1. One of ordinary skill in the art would recognize that using the modified Nakamura lid 3 to bend bottle caps could cause deformation of the lid and separation between the edges of the lid 3 and the housing 2. Contaminants could thus enter the battery storing recess 2A. One of ordinary skill in the art would therefore recognize that using the Nakamura lid 3 in a manner proposed in the Office Action would tend to lead to contamination of the battery recess 2A resulting in impaired performance. These types of real world problems would deter one of ordinary skill in the art from making the proposed combination.

Consequently, Nakamura's thin-walled housing/lid construction, smooth exterior contour for gripping, and desired functionality would deter one of ordinary skill in the art from the Office Action's proposed modification of the Nakamura lid.

Office Action's Proposed Combination is Unsuitable for Donnelly's Intended Purpose of Protecting and Disassembling a Tool From the Personal Communication Device Before Using the Donnelly Tool

The Office Action's proposed modification of the Nakamura lid 3 to incorporate the Donnelly tool 62 would render the Donnelly tool 62 unsatisfactory for the intended purpose of disassembling the component, which is used to remove a bottle cap from a personal communication device, before use, and thus, there is no suggestion or motivation to make the proposed modification. As stated in the M.P.E.P., "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01(V); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Donnelly recognizes problems (*e.g.*, user injury, damage to clothing, etc.) associated with the tool 62. (Col. 5, lines 44-52.) The tool 62 is protected by a sheath 64 and can be moved away from the telephone to open bottles. One

of ordinary skill in the art would recognize the advantages of disassembling the tool 62 from the telephone to avoid problems (for example, user injury) when using the tool 62 as a bottle opener. The Office Action improperly disregards the problems recognized by Donnelly, and then proposes to somehow incorporate the features of Donnelly into the Nakamura lid 3, even though the Nakamura telephone does not have protective components, such as a sheath. Making the Donnelly tool 62 integral with the Nakamura lid 3 could cause the unwanted problems recognized by Donnelly supporting nonobviousness.

Office Action's Proposed Combination Involves Substantial Reconstruction and Changes the Basic Principle of Operation of the Nakamura Lid and Donnelly Belt Clip Tool

It is respectfully submitted that a *prima facie* case of obviousness also has not been presented because the suggested combination of cited references would involve substantial reconstruction and redesign of the components shown in Nakamura and Donnelly and would change the basic principle under which the cited features of Nakamura and Donnelly were designed to operate. A substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the primary reference construction was designed to operate supports nonobviousness. *See* M.P.E.P. § 2143.01(VI); *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (CCPA 1959). The technical challenges of such substantial reconstruction and redesign would further deter one of ordinary skill in the art from the Office Action's proposed modification. The Nakamura lid 3 has numerous features (*e.g.*, a specific shape, wall thickness, structural features for coupling to the housing 2, etc.) for providing a lightweight telephone that can be comfortably gripped. The Office Action fails to set forth which features of Nakamura would be eliminated/modified/replaced, fails to explain with any reasonable specificity how the cited references could be combined, and fails to provide a proper motivation to eliminate/modify/replace the features of Nakamura to allow the Nakamura lid 3 to somehow function as a bottle opener. The Office Action simply fails to appreciate the significant changes in weight, dimensions, and physical properties of the Nakamura lid 3 that would be needed to somehow make the Nakamura lid 3 function as a bottle opener.

Office Action Bases Rejection on Conclusory Statements

The Office Action summarily concludes that combining Nakamura and Donnelly would have been obvious without providing a clearly articulated reason for redesigning the Nakamura lid 3, so that the lid 3 is capable of bending a bottle cap. The Office Action, on page 6, merely states that “it would have been obvious to one of ordinary skill at the time the invention was made to modify Nakamura to incorporate the lever element being arranged to be a material of lower hardness The motivation for the modification is to do so in order to provide a lever element incorporating the bottle cap opener such that the user can enjoy the benefit of using the lever element for multipurpose use.” (Office Action, page 5, first full paragraph.) This ignores the fact that the belt clip 60 of Donnelly is already designed to couple to a telephone. That is, Donnelly already provides the bottle cap opening functionality without requiring reconstruction of a lid. The Examiner fails to articulate a specific reason to modify the Nakamura lid 3 with the teachings of Donnelly to somehow enable the Nakamura lid 3 to be not only a lever element, but a lever element capable of bending a bottle cap. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited in KSR Int’l Co. v. Teleflex Inc., et al.*, 127 S. Ct. 1727, 1740-1741 (2007). The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)) (emphasis added); *see also KSR Int’l Co.* at 1740-1741 (2007) (Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue) (emphasis added). Moreover, the Office Action failed to detail how one of ordinary skill in the art would modify the Nakamura lid 3 to operate as a lever element as claimed, as detailed above. Consequently, the Office Action’s rejections are improperly based on conclusory statements.

Dependent Claims 3-5

Dependent claims 3-5 are allowable as depending from allowable base claim 1, as well as for novel and nonobvious combinations of elements recited therein.

New Claims

Claims 14 and 15 have been added. These claims are fully supported by the application as filed. No new matter has been added. The cited references fail to disclose features of claims 14 and 15. For example, Nakamura and Donnelly, alone or in combination, the lever element is an angled lever element that provides an angle to provide the leverage effect as recited in claim 13. Nakamura and Donnelley, alone or in combination, fail to disclose that most of a telephone housing is non-metal and a lever element comprises metal, as recited in claim 15. Thus, Applicants respectfully submit that claims 14 and 15 are in condition for allowance.

Conclusion

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
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Enclosures:

Redlined Substitute Specification
Substitute Specification

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